

## **REMARKS**

Claims 1, 11, 20, 30, 39 and 49 have been amended. Claims 1-9, 11-18, 20-28, 30-37, 39-47 and 49-56 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Examiner Interview Summary Pursuant to 37 C.F.R. § 1.133(b)**

On February 17, 2010, Examiner Joshua Joo, and attorneys for Applicant (Robert C. Kowert, Reg. No. 39,255 and Chris Drymalla, Reg. No. 61,843) participated in a telephone interview to discuss certain rejections of the claims. During the interview, proposed after-final claim amendments were discussed. As a result of the interview, Examiner Joo agreed that the proposed amendments would differentiate the claims over the cited art, and requested that Applicants submit amendments to the claims via a request for continued examination.

### **Double Patenting Rejections:**

The Office Action provisionally rejected claims 1, 8, 9, 20, 27, 28, 39, 46 and 47 under the judicially-created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1, 12-15, 26-29 and 40-42 of co-pending Application No. 10/670,550 in view of Wick (U.S. Publication 2004/0093387) (hereinafter Wick), claims 11, 17, 18, 30, 36, 37, 49, 55 and 56 over claims 1, 12-15, 26-29 and 40-42 co-pending Application No. 10/670,550 in view of Malik (U.S. Patent 7,353,455) (hereinafter "Malik"), claims 1, 8, 9, 20, 27, 28, 39, 46 and 47 over claims 1, 8-11, 18-21, 28, 29 and 30 of co-pending Application No. 10/670,549 in view of Wick, claims 11, 17, 18, 30, 36, 37, 49, 55 and 56 over claims 1, 8-11, 18-21, 28, 29 and 30 of co-pending Application No. 10/670,549 in view of Malik.

Applicant acknowledges the provisional rejections. If and when these rejections become non-provisional, Applicant will either submit a terminal disclaimer or present

arguments traversing the rejections. The rejections should also be reconsidered in light of the above amendments to the claims and any changes to the claims in the co-pending application(s).

**Section 102(e) Rejection:**

The Office Action rejected claims 11, 12, 14, 30, 31, 33, 49, 50 and 52 under 35 U.S.C. § 102(c) as being anticipated by Malik.

**Independent Claim 11**

Claim 11 recites a combination of features including, but not limited to:

- receiving an instant messaging operation associated with a specific presence state of an instant messenger that receives the instant messaging operation;
  - storing the instant messaging operation associated with the specific presence state of the instant messenger, wherein the specific presence state associated with the received instant messaging operation is determined separately from a current presence state that is currently assigned to the instant messenger, wherein said specific presence state is selected from a plurality of possible presence states other than a presence state that indicates only that a given user of the instant messenger is online;
  - detecting a transition of said current presence state assigned to said instant messenger to said specific presence state subsequent to said storing, such that as a result of said transition, the specific presence state becomes visible to other users as indicative of said given user and indicates presence information other than just that the given user of the instant messenger is online; and
  - performing said instant messaging operation in response to said detecting;
- wherein each of said storing, said detecting, and said performing is implemented by one or more computer systems.

The Office Action rejects claim 11 as being anticipated by features disclosed by Malik. Malik, however, relates to a first communications client of a first user detecting a change in the presence of status of the first user and sending an alert message to a second communication client of a second user. (Malik, abstract). That is, a presence state

change of the sender is detected, and a corresponding alert is sent to another user based on the presence state change of the sender. As discussed in the Examiner interview, Malik taken alone or in combination with the other cited art does not teach or suggest at least the features of, “receiving an instant messaging operation associated with a specific presence state of an instant messenger that receives the instant messaging operation,” in combination with other features of the claim.

Applicant respectfully submits that claim 11 is allowable over the cited art for at least these reasons. Moreover, claims 30 and 49 recite similar features and are, thus, allowable over the cited art for at least the discussed reasons.

### **Section 103(a) Rejections:**

The Office Action rejected claims 13, 15, 17, 32, 34, 36, 51, 53 and 55 under 35 U.S.C. § 103(a) as being unpatentable over Malik in view of Horvitz (U.S. Publication 2002/0087649) (hereinafter “Horvitz ‘649”), claims 16, 35 and 54 as being unpatentable over Malik in view of Cristofalo et al. (U.S. Publication 2002/0152117) (hereinafter “Cristofalo”), claims 18, 37 and 56 as being unpatentable over Malik in view of Horvitz (U.S. Publication 2008/0104517) (hereinafter “Horvitz ‘517”), claims 1-3, 5, 7, 20-22, 24, 26, 39-41, 43 and 45 as being unpatentable over Wick in view of Seshadri et al. (U.S. Patent 7,209,916) (hereinafter “Seshadri”), claims 4, 23 and 42 as being unpatentable over Wick and Seshadri in view of Cristofalo, claims 6, 25 and 44 as being unpatentable over Wick and Seshadri in view of Beyda (U.S. Publication 2003/0229722) (hereinafter “Beyda”), claims 8, 27 and 46 as being unpatentable over Wick and Seshadri in view of Horvitz, and claims 9, 28 and 47 as being unpatentable over Wick and Seshadri in view of Horvitz ‘517. Applicant respectfully traverses these rejections for at least the following reasons.

#### **Independent Claim 1**

Claim 1 recites a combination of features including, but not limited to:

- receiving an instant messaging operation directed to a given user of an instant messenger, wherein said given user is not offline, wherein said instant messaging operation is associated with a specific presence state of the instant messenger, wherein the specific presence state associated with the received instant messaging operation is determined separately from a current presence state that is currently assigned to the instant messenger, and wherein said current presence state is selected from a plurality of possible presence states other than a presence state that indicates only that the given user of the instant messenger is online;
- in response to receiving said instant messaging operation, determining whether the current presence state that is currently assigned to said instant messenger matches the specific presence state associated with the received instant messaging operation, wherein said current presence state corresponds to said given user and indicates presence information other than just that the given user of the instant messenger is online; and
- in response to determining that said specific presence state of the received instant messaging operation matches said current presence state assigned to said instant messenger, performing said instant messaging operation;

wherein each of said receiving, said determining, and said performing is implemented by one or more computer systems.

The Office Action rejects claim 1 over Wick in view of Seshadri. Wick, however, relates to detecting that a targeted user has signed onto a network, and upon detecting the sign-on, automatically communicating with the targeted user, for example, by sending an instant message previously specified by a targeting user. (Wick, abstract). That is Wick discloses sending an instant message to a user based on the user signing onto a network. As discussed in the examiner interview, Wick taken alone or in combination with the other cited art does not teach or suggest at least the features of, “wherein said current presence state is selected from a plurality of possible presence states other than a presence state that indicates only that the given user of the instant messenger is online,” in combination with other features of the claim.

Applicant respectfully submits that claim 1 is allowable over the cited art for at least these reasons. Moreover, claims 20 and 39 recite similar features and are, thus, allowable over the cited art for at least similar reasons.

#### Dependent Claims

Applicant also asserts that the rejections of numerous ones of the dependent claims are further unsupported by the cited art. However, since the rejections have been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

## CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-69900/RCK.

Respectfully submitted,

/Robert C. Kowert/

Robert C. Kowert, Reg. #39,255  
Attorney for Applicant

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.  
P.O. Box 398  
Austin, TX 78767-0398  
Phone: (512) 853-8850

Date: March 1, 2010